Remarks

The various parts of the Office Action (and other matters, if any) are discussed below under appropriate headings. Pursuant to the previous election, claims 18-28 have been withdrawn. Claims 16 and 17 have been canceled, and claims 1-15 remain pending the application.

Election/Restriction

Non-elected claims 18-28 have been canceled without prejudice or disclaimer of the subject matter contained therein.

Drawings

In accordance with the Examiner's request, replacement drawing sheets have been provided.

Claim Rejections - 35 USC § 112

The Examiner rejects claims 6, 7, and 13 pursuant to 35 U.S.C. § 112, second paragraph, for indefiniteness. In particular, the Examiner states that the phrases "runs conically" (claim 6) and "conically running" (claims 7 and 13) are unclear. In addition, the Examiner states that claim 7 is unclear where it states, "wherein the guiding sleeve includes a rotational block the conically running end area". Clarifying amendments have been made. Therefore, the rejection should be withdrawn.

Claim Rejections - 35 USC § 102 and § 103

Claim 1, as amended, recites a system for positioning an implant that includes, *inter alia*, a holding element and a guiding sleeve for guiding the holding element, wherein the holding element is removably introduceable into the guiding sleeve and wherein the holding element is configured to be translated and rotated within the guiding sleeve.

Bertuch, Jr. has not been found to disclose or fairly suggest a holding element that is removably introduceable into a guiding sleeve, wherein the holding element is configured to be translated and rotated within the guiding sleeve. While the Examiner states that Bertuch, Jr. discloses a system for positioning an implant 109 comprising a holding element 97, 103 and a guiding sleeve 81 (referring to the embodiment in Figs. 8-13), it is respectfully submitted that this disclosure is insufficient to anticipate or

render obvious amended claim 1. In this particular embodiment of Bertuch, Jr., the implant 109 is released by squeezing a plunger handle to drive a push-pull cable. (See Bertuch, Jr. at col. 2, ln. 66 to co. 3, ln. 2.) In this system, structure 81 is actually the drive housing and structure 97 is the drive cable. In contrast, the claimed invention does not operate as a push-pull drive cable system. Rather, the holding element is removably introducable into the guiding sleeve and has a wider range of motion therein, including rotation. As such, Bertuch Jr.'s drive housing and drive cable provide different structure than that recited in amended claim 1.

For at least these reasons, amended **claim 1** and **claims 2-13** dependent therefrom are not anticipated by Bertuch, Jr. Therefore, the rejection should be withdrawn.

In addition, other dependent claims recite features not disclosed or fairly suggested by the reference relied on in the office action. For example, **claim 4**, as amended, further recites a navigation element fixed to the guiding sleeve, the navigation element having markers that are trackable by a navigation system.

The Office Action acknowledges that Bertuch, Jr. fails to disclose or fairly suggest any navigation element/system, but turns to Bertin to cure the deficiencies of Bertuch, Jr. While Bertin is understood to disclose a prosthesis orientation bar 102 disposed on a pair of prosthesis orientation legs 104, 106, this device is far different from the navigation element recited in amended claim 4. For example, the prosthesis orientation bar of Bertin is a piece of hardware manipulated by a user of the device, and not a navigation element having markers trackable by a navigation system. As such, neither Bertuch, Jr. nor Bertin discloses or fairly suggests the claimed navigation element recited in claim 4. For at least this additional reason, the rejection of **claim 4** should be withdrawn.

In addition, dependent **claim 5** further recites a sliding element connected to a navigation element, the sliding element slidingly engaging the guiding sleeve.

While the Office Action points to Bertin for disclosure of a system for positioning an implant 53 comprising a holding element 82, a guiding sleeve 96, and a navigational system 102, 104, this disclosure is insufficient to render obvious claim 5. In addition, the claimed invention does not operate in a manner comparable to Bertin. Similar to Bertuch, Jr., the purported holding element in Bertin is not removable from the guiding sleeve and does not have the range of motion therein, as compared to the claimed invention. (See, e.g., the operation of the Bertin device, at col. 13, ln. 5-27 and Figure

5.) As such, neither Bertuch, Jr. nor Bertin discloses or fairly suggests the claimed navigation element and sliding element recited in claim 5. For at least this additional reason, the rejection of **claim 5** should be withdrawn.

Claim 14, as amended, recites a guiding sleeve having a first rim defining an entry opening and a second rim defining an exit opening, and having a guiding area between the openings for guiding the holding element, wherein the guiding sleeve is configured to support a holding element that is translatable and rotatable within the guiding sleeve.

Bertuch, Jr. fails to disclose or fairly suggest the claimed guiding sleeve, wherein the guiding sleeve is configured to support a holding element that is translatable and rotatable within the guiding sleeve. As is discussed above with respect to amended claim 1, Bertuch, Jr.'s disclosure of an implant 109 released by squeezing a plunger handle to drive a push-pull cable fails to anticipate the invention recited in claim 14. In the Bertuch, Jr. system, structure 81 is actually the drive housing and structure 97 is the drive cable. In contrast, the claimed invention does not operate as a push-pull drive cable system. Rather, the claimed guiding sleeve is configured to support a holding element that is translatable and rotatable within the guiding sleeve. As such, Bertuch Jr.'s drive housing and drive cable provide different structure than that recited in amended claim 14.

For at least these reasons, Bertuch, Jr. does not anticipate amended claim 14. Therefore, the rejection of **claim 14** and dependent **claim 15** should be withdrawn.

Amended **claim 15** further recites a navigation element coupled to an outer portion of the guiding sleeve, where the navigation element includes markers that are trackable by a navigation system. As is discussed above with respect to claim 4, the claimed navigation element is a completely different element from the prosthesis orientation bar 102 disposed on a pair of prosthesis orientation legs 104, 106, which is disclosed in Bertin. As such, neither Bertuch, Jr. nor Bertin discloses or fairly suggests the claimed navigation element recited in claim 15. For at least this additional reason, the rejection of **claim 15** should be withdrawn.

Conclusion

In view of the foregoing, request is made for timely issuance of a notice of allowance of claims 1-15.

Respectfully submitted,

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